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OFFICE OF PETITIONS

In re Patent No. 6,603,052 :
Issue Date: August 5, 2003 :
Application No. 09/865,822 : DECISION ON PETITION
Filed: May 25, 2001 : UNDER 37 CFR 1.378(e)
For: TRIL-05/119 :

This is a decision on the petition under 37 CFR 1.378(e), filed November 19, 2010, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DENIED**¹.

BACKGROUND

The patent issued August 5, 2003. The 3.5 year maintenance fee could have been paid from August 5, 2006, through February 5, 2007, or with a surcharge during the period from February 6, 2007 through August 5, 2007. Accordingly, the patent expired as of midnight on August 5, 2007 for failure to timely submit the 3.5-year maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed June 29, 2010. A decision dismissing the petition under 37 CFR 1.378(b) was mailed September 21, 2010 and is hereby incorporated by reference.

Petitioner under 37 CFR 1.378(e) in seeking reconsideration of the decision under 37 CFR 1.378(b) attributes the failure to timely pay the maintenance fee to the medical condition of patentee John E. Davis and to Laura Brumbaugh's docketing system, which failed to alert Ms. Brumbaugh of the maintenance fee due date.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

In accordance with 35 USC 41(c)(1), "[t]he Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. *See*, MPEP 1002.02.

month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.”

In accordance with 37 CFR 1.378(b), “[a]ny petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include: (1) The required maintenance fee set forth in § 1.20 (e) through (g); (2) The surcharge set forth in § 1.20(i)(1); and (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.”

FACTS

The patentees of record are joint inventors John E. Davis and Timothy P. Klonne. The joint inventors were partners in TollamCo, Corp. Mr. Davis is represented by counsel of the law firm of Wood, Herron & Evans, LLP (WHE). It is noted that maintenance fee reminder letters sent from WHE to Mr. Davis care of TollamCo, Corp. were returned to WHE as undeliverable.

Mr. Davis alleges to have suffered a stroke around the time that the patent issued. Mr. Davis alleges to still suffer from the effects of the stroke, including memory issues. Mr. Davis is also said to suffer from heart disease. Petitioner has provided some medical documentation for Mr. Davis.

Petitioner, John E. Davis, asserts that TollamCo, Corp. was liquidated from May 2003 to November 2003. Petitioner asserts that Mr. Davis maintained the corporate records and files for TollamCo, Corp. The records are said to have been housed by Blue Horizon, Inc., a company owned by Mr. Davis’ daughter Laura Brumbaugh. On August 8, 2003, WHE forwarded the Letters Patent to Mr. Davis at the address of his daughter. Laura Brumbaugh was assisting Mr. Davis in his recovery as well as managing Mr. Davis’ financial and business affairs. Thereafter, the Letters Patent was housed in a drawer at Blue Horizon, Inc. on behalf of Mr. Davis, who was not working at that time. Mr. Davis does not recall receiving or reading the original patent. Eventually, TollamCo, Corp. files were moved from Blue Horizon, Inc. to Newport Converting, another corporation owned by Ms. Brumbaugh.

Petitioner acknowledges that there was no docketing system in place by Mr. Davis or at TollamCo, Corp. for the patent. Petitioner acknowledges that due to Mr. Davis’ health condition, Mr. Davis has no recollection of receiving the patent. Mr. Davis asserts that he did not note the maintenance fee due dates or docket the due dates for payment. Instead, Mr. Davis asserts that he authorized his daughter, Laura Brumbaugh, to act on his behalf with respect to the patent.

Ms. Brumbaugh asserts that shortly after the patent issued, she received the Letters Patent and the attached letter from WHE wherein patentees were advised of the need to pay maintenance fees. Ms. Brumbaugh asserts that she entered an August 2006 maintenance fee reminder in her computer calendar system, “ACT.” Ms. Brumbaugh further asserts that the computer that

maintained the ACT calendar system crashed in November of 2003. Ms. Brumbaugh asserts that some data files were recovered, but there was no way of knowing if all the data stored in the ACT calendar system had been recovered at the time that the new hard drive was installed on her computer. Ms. Brumbaugh became aware that not all data had been recovered when the ACT calendar system failed to alert her for some calendar events. Ms. Brumbaugh asserts that the ACT calendar system did not provide a maintenance fee due reminder for the instant patent in August of 2006.

Petitioner asserts that patentee Timothy P. Klonne verbally assigned his rights to the patent in August 2003. Petitioner has provided a statement from Mr. Klonne wherein he stated he verbally assigned his rights to the patent to Mr. Davis.

Petitioner asserts that on September 22, 2009, Mr. Davis discovered the Letters Patent while going through old files. On September 22, 2009, Mr. Davis contacted his legal counsel at WHE to seek information regarding the maintenance fee for the instant patent. WHE advised Mr. Davis that the maintenance fee had not been paid and that the patent was expired for non-payment of the maintenance fee. Mr. Davis indicated he wanted to revive the patent and pay the maintenance fee due. On September 25, 2009, WHE advised Mr. Davis that he was going to have to investigate the facts regarding the owner of the Patent, the actions of the owner, and provide information surrounding the patent, the maintenance fees, and other issues in order to determine that the delay of the payment was unavoidable.

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". See, 35 U.S.C. § 41(c)(1). Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, patentees must show that they were aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but

when the fee came due, was "unavoidably" prevented from making the maintenance fee payment.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that patentees or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the issue of Mr. Davis' medical condition is immaterial in the absence of a showing that his medical condition, and not the lack of adequate steps in place to pay the fee, caused or contributed to the delay.

Petitioner fails to establish that patentees Mr. Davis, Mr. Klonne, or Ms. Brumbaugh, who was responsible for acting on behalf of Mr. Davis, took adequate steps to ensure that the maintenance fee would be timely paid. Petitioner fails to establish that Mr. Davis, Mr. Klonne, or Ms. Brumbaugh had a reliable system in place to track the maintenance fee due date for the patent. Thus, it appears that the lack of a reliable system for tracking the maintenance fee due date, rather than Mr. Davis' medical condition (alleged strokes and heart disease), was the requisite cause of the failure to timely remit the maintenance fee.

The supporting medical documentation does not explicitly set forth the time periods during which Mr. Davis was deemed incapacitated. Given that Mr. Davis authorized Ms. Brumbaugh to act on his behalf with respect to the maintenance fee, the alleged medical conditions of Mr. Davis are not found to be the requisite cause of the delay in timely remittance of the maintenance fee.

Instead, the failure to pay the maintenance fee can be attributed to the inadequate docketing system maintained by Ms. Brumbaugh.

Ms. Brumbaugh alleges that the computer which maintained the calendar docketing system ACT crashed in November 2003. No supporting documentation has been provided to substantiate this claim. Ms. Brumbaugh fails to provide details or supporting documentation regarding the recovery of data from the computer's hard drive. Ms. Brumbaugh has provided no information and supporting documentation regarding the ACT calendar system. Ms. Brumbaugh has not provided any printouts from the ACT calendar system to document the manner in which the system worked. Ms. Brumbaugh has provided no documentation from the patent file said to have been maintained by Ms. Brumbaugh's company.

A new hard drive was installed in the computer and the ACT database was reinstalled on the computer. Ms. Brumbaugh acknowledges that all data contained on the computer, including data from the ACT calendar system, was not restored. Ms. Brumbaugh has provided no information regarding the cause of the crash and what steps were taken to recover the lost data, knowing that all of the data for the ACT database was not restored. As no further information and documentation concerning the computer crash has been provided, it cannot be found that the failure to submit the maintenance fee was unavoidable.

Ms. Brumbaugh was in possession of the August 2003 letter from WHE which advised of the need to pay the maintenance fee. As Ms. Brumbaugh was aware that not all data had been restored on the computer, it is unknown why Ms. Brumbaugh did not utilize the letter to reenter the maintenance fee due date into the ACT calendar system. Accordingly, it is not found that Ms. Brumbaugh maintained a reliable docketing system.

Thus, it cannot be found that adequate steps were taken by all the responsible parties to ensure that the maintenance fee would be timely paid. Accordingly, the petition for reinstatement of the patent must be denied.

DECISION

The prior decision dismissing petition under 37 CFR 1.378(b) to accept delayed payment of maintenance fee has been reconsidered,. For the reasons set forth herein, the delay in payment of the maintenance fee cannot be regarded as unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b). Accordingly, the offer to pay the delayed maintenance fee will not be accepted and this patent will not be reinstated.

Petitioner may request a refund of the previously submitted fee of \$1,190.00 by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

Telephone inquiries concerning this matter may be directed to Attorney Advisor Alesia M. Brown at 571-272-3205.



Anthony Knight
Director
Office of Petitions